

### **REMARKS**

Claims 1, 4-7, 9-12, 14, and 16-21 are all the claims presently pending in the application. The Examiner has withdrawn claims 7, 9, and 18 from consideration. Applicants have amended claims 1 and 14 to define the claimed invention more particularly. Applicants have canceled claim 2 without prejudice or disclaimer. Applicants have added new claim 21 to provide varied protection for the claimed invention and claim additional features of the invention.

Claims 1, 10-12, 14, 19 and 20 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Kurachi (U.S. Patent No. 6,181,436). Claims 1, 10-12, 14, 19 and 20 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Thorne, et al. (U.S. Patent No. 5,958,005; hereinafter “Thorne”). Claim 2 stands rejected under 35 § 103(a) as being unpatentable over Kurachi in view of Koyama et al. (U.S. Patent No. 6,011,897; hereinafter “Koyama”).

Applicants respectfully traverse these rejections in the following discussion.

#### **I. THE PRIOR ART REJECTIONS**

##### **A. The Kurachi Reference**

The Examiner alleges that Kurachi teaches the claimed invention of claims 1, 10-12, 14, 19, and 20. Applicants respectfully submit, however, that Kurachi does not teach or suggest every feature of the claimed invention.

First, Kurachi does not teach or suggest an image server including “*an encryption unit for encrypting the image data using an encryption key which corresponds to the client*”

*terminal that has been selected by said selection unit*”, as recited in exemplary claim 1, and somewhat similarly recited in exemplary claim 14.

Second, Kurachi does not teach or suggest, “*wherein the image data includes high-resolution image data for printing and display image data having a resolution lower than that of the high-resolution image data for printing, said encryption unit encrypting the high-resolution image data for printing*”, as recited in exemplary claim 1, and similarly recited in exemplary claim 14.

Indeed, the Examiner concedes that Kurachi does not teach or suggest this feature of the claimed invention (e.g., see Office Action dated July 26, 2007 at page 10).

Kurachi teaches that a print data encryption device 201g may encrypt the print data (e.g., see Kurachi at column 14, lines 47-54). The print data encryption device 201g is not part of the image server. Indeed, the print data encryption device 201g is part of the client apparatus 201 (e.g., see Figure 9).

Moreover, Kurachi does not teach or suggest “*a format conversion unit for converting a format of the applied image data so as to obtain a format conforming to the image printing unit that has been designated by said designation unit*”, as recited in exemplary claim 10 and somewhat similarly recited in exemplary claim 19.

Kurachi merely teaches that a size of the rough image may be changed based on a selected print paper size (see Kurachi at column 12, lines 16-19). Kurachi does not teach or suggest changing the format of the image data and, more specifically, does not teach or suggest converting a format of the applied image data to conform to the designated printing unit.

Moreover, Kurachi does not teach or suggest “*a format conversion unit for converting the data representing the printing history read by said reading unit to data having a predetermined format*”, as recited in exemplary claim 12 and somewhat similarly recited in exemplary claim 20.

Indeed, Kurachi merely teaches listing a number of print jobs and identifying one or more print jobs in the list of print jobs (see Kurachi at column 11, lines 5-45). Kurachi, however, does not teach or suggest converting the list of print jobs.

Therefore, Applicants respectfully submit that Kurachi does not teach or suggest every feature of the claimed invention. Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw this rejection.

Furthermore, Applicants respectfully submit that the rejection of claims 1, 10-12, 14, 19, and 20 based on Kurachi fails to conform with 37 C.F.R. § 1.104, which states: “When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.” (Emphasis added by Applicants).

Applicants respectfully submit, however, that the rejection of claims 1, 10-12, 14, 19, and 20 does not identify the particular part relied upon and the pertinence of Kurachi has not been clearly explained. Indeed, the Examiner has merely copied Applicants’ claim language and provided vague references to passages in the disclosure of Kurachi.

If the Examiner wishes to maintain this rejection, Applicants respectfully request the Examiner to conform the rejection to the standard set forth in 37 C.F.R. § 1.104.

**B. The Thorne Reference**

The Examiner alleges that Thorne teaches the claimed invention of claims 1, 10-12, 14, 19, and 20. Applicants respectfully submit, however, that Thorne does not teach or suggest every feature of the claimed invention.

Applicants respectfully submit that the Examiner's rejection based on Thorne is unclear. Indeed, as indicated above, claims 1, 10-12, 14, 19, and 20 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Thorne. The body of the Examiner's rejection, however, does not refer to claims 1, 10-12, 14, 19, and 20. Instead, the body of the Examiner's rejection refers to claims 4-6, 16, and 17. Accordingly, it is not clear which claims the Examiner is actually rejecting based on Thorne.

Accordingly, Applicants respectfully request the Examiner to clarify this rejection in a new non-final Office Action.

Notwithstanding the above, Applicants submit that Thorne does not teach or suggest *“a printing unit, which is responsive to a print command applied by said print command unit, for printing, on the same visible recording medium, the image that has been selected by said image selection unit and information relating to a copyright holder of the selected image”*, as recited in exemplary claim 4, and somewhat similarly recited in claims 6, 16, and 17.

Indeed, Thorne does not even mention a copyright holder with respect to the printing operation.

Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw this rejection.

Moreover, Applicants respectfully submit that the rejection of claims 1, 10-12, 14, 19, and 20 based on Thorne fails to conform with 37 C.F.R. § 1.104, which states: “When a

reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.” (Emphasis added by Applicants).

Applicants respectfully submit, however, that the rejection of claims 1, 10-12, 14, 19, and 20 does not identify the particular part relied upon and the pertinence of Thorne has not been clearly explained. Indeed, the Examiner has merely copied Applicants’ claim language and provided vague references to passages in the disclosure of Thorne.

If the Examiner wishes to maintain this rejection, Applicants respectfully request the Examiner to conform the rejection to the standard set forth in 37 C.F.R. § 1.104.

### **C. The Koyama Reference**

The Examiner alleges that one of ordinary skill in the art would have combined Koyama with Kurachi to render obvious the claimed invention of claim 2.

Applicants respectfully submit, however, that claim 2 is allowable over the alleged combination at least for similar reasons to those set forth above in section A.

Moreover, the alleged combination of references does not teach or suggest, “*wherein the image data includes high-resolution image data for printing and display image data having a resolution lower than that of the high-resolution image data for printing, said encryption unit encrypting the high-resolution image data for printing*”, as recited in exemplary claim 1, and similarly recited in exemplary claim 14.

According to the claimed invention, since the display image data is not necessarily encrypted (as defined in exemplary dependent claim 21), it can be displayed without

decryption. Because the display image data has a resolution lower than that of the image data for printing, damage ascribable to any unlawful use will be minimal.

As detailed above in section A, the Examiner concedes that Kurachi does not teach or suggest this feature of the claimed invention.

The Examiner, however, alleges that Koyama teaches image data that includes high-resolution image data for printing and display image data having a resolution lower than that of the high-resolution image data for printing (relying on column 11, lines 30-46 of Koyama for support). Koyama, however, merely teaches two kinds of resolution image data and does not teach or suggest the specific limitation of the claimed invention.

Therefore, Koyama fails to make up the deficiencies of Kurachi.

Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw this rejection.

## **II. NEW CLAIM**

Applicants have added new claim 21 to claim additional features of the invention and to provide varied protection for the claimed invention. This claim is independently patentable because of the novel and non-obvious features recited therein.

Applicants submit that new claim 21 is patentable over any combination of the cited references at least based on similar reasons to those set forth above with respect to claims 1, 2, 4-7, 9-12, 14, and 16-20.

### III. FORMAL MATTERS AND CONCLUSION

As previously pointed out in the Petition for New Office Action and to Restart Period to Respond to Office Action, which was filed on August 23, 2007, Applicants submit that the Office Action dated July 26, 2007 fails to properly address every claim pending the Application.

Specifically, the Office Action summary indicates that claims 1, 2, 4-7, 9-12, 14, and 16-20 are pending in the Application and that claims 1, 2, 4-6, 10-12, 14, 16, 17, 19, and 20 stand rejected. The Office Action, however, does not properly set forth a ground of rejection for each of claims 1, 2, 4-6, 10-12, 14, 16, 17, 19, and 20.

That is, the sole rejections set forth in the Office Action dated July 26, 2007 are as follows:

- 1) Claims 1, 10-12, 14, 19 and 20 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Kurachi (U.S. Patent No. 6,181,436);
- 2) Claims 1, 10-12, 14, 19 and 20 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Thorne, et al. (U.S. Patent No. 5,958,005; hereinafter “Thorne”);  
and
- 3) Claim 2 stands rejected under 35 § 103(a) as being unpatentable over Kurachi in view of Koyama et al. (U.S. Patent No. 6,011,897; hereinafter “Koyama”).

The Office Action does not properly set forth a ground of rejection for claims 4-6, 16, and 17.

Applicants respectfully request appropriate correction in a **new non-final** Office Action.

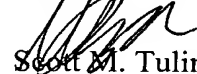
Since this defect in the Office Action was brought to the attention of the Patent Office within one (1) month of the mailing date of the Office Action, the Examiner was should have issued a new Office Action correcting the defect and restarting the time period to respond to the Office Action. Since the Examiner failed to correct the defect, as required under M.P.E.P. § 710.06, the Examiner is **precluded** from issuing a Final Office Action in his next action.

In view of the foregoing, Applicant submits that claims 1, 4-7, 9-12, 14, and 16-21, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, Applicants request the Examiner to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

Applicants hereby authorize the Examiner to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

  
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